

REMARKS

Claims 8, 9, 11, and 14 to 16 are canceled without prejudice, and therefore claims 7, 10, 12, 13, 17 and 18 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for indicating that claims 15 to 18 contain allowable subject matter. While the objections may not be agreed with, to facilitate matters, claim 7 has been rewritten to include the features of claim 15, which has been canceled without prejudice. Claim 17 has also been rewritten as an independent claim by including the features of claim 7. Also, claims 8, 9, 11, 14, and 16 have been canceled without prejudice, since their features are present in claim 7, as presented. Accordingly, claims 7, 10, 12, 13, 17 and 18 are allowable, and it is therefore respectfully requested that the objections be withdrawn.

Claims 15 and 17 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

While the rejections may not be agreed with, the term “a pressure” has been revised to “an admission pressure” in claim 17. Since claim 7 has been rewritten to include the features of claim 15, which has been canceled without prejudice, claim 7 as presented, also is rewritten to reflect this revision.

It is therefore respectfully requested that the indefiniteness rejections be withdrawn.

Claims 7 to 9 are rejected under 35 U.S.C. § 102(b) as anticipated by Beck et al. (“the Beck reference”), U.S. Patent No. 6,560,088.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having

ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the anticipation rejections may not be agreed with, to facilitate matters, claim 7 has been rewritten to include the features of claim 15, which has been canceled without prejudice. Claim 17 has also been rewritten as an independent claim by including the features of claim 7. Also, claims 8, 9, 11, 14, and 16 have been canceled without prejudice, since their features are present in claim 7, as presented. Accordingly, claims 7, 10, 12, 13, 17 and 18 are allowable, and it is therefore respectfully requested that the objections be withdrawn.

Withdrawal of the anticipation rejections of these claims is therefore respectfully requested.

Claims 10 to 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over the Beck reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*,

127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the obviousness rejections may not be agreed with, to facilitate matters, claim 7 has been rewritten to include the features of claim 15, which has been canceled without prejudice. Claim 17 has also been rewritten as an independent claim by including the features of claim 7. Also, claims 8, 9, 11, 14, and 16 have been canceled without prejudice, since their features are present in claim 7, as presented. Accordingly, claims 7, 10, 12, 13, 17 and 18 are allowable, and it is therefore respectfully requested that the objections be withdrawn.

Withdrawal of the obviousness rejections of these claims is therefore respectfully requested.

In sum, it is respectfully submitted that claims 8, 9, 11, and 14 to 16 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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